

Remarks

The non-final Office Action dated October 23, 2007 indicated that claims 1-9 stand rejected under 35 U.S.C. § 102(e) over the Widergren reference (U.S. Patent Pub. 2004/0228169, hereinafter the " '169 reference").

The Section 102(e) rejection must be removed because the cited portions of the '169 reference do not correspond to the claimed invention as asserted, and further because the rejection relies upon the Examiners' unsupported "determination" of what the '169 reference "could do" without providing actual correspondence to the claimed invention. In short, the '169 reference fails to disclose claim limitations directed to a processor for searching for and supplying a stored "predefined second data piece" when the second data piece is available, and for "transcoding a corresponding first data piece into the predefined second data piece" when the second data piece is unavailable. These limitations are related to processing incoming "first" data in a first format to provide "second" data (corresponding to the first data) in a format that is different than the first format by either generating the second data or retrieving the second data from storage (if available). In an attempt to show correspondence to these limitations, the Office Action relies upon an assertion of what the '169 reference "could do" without citing any portion of the '169 reference that actually provides correspondence to these claim limitations. Effectively, the Examiner has introduced a process to the '169 reference that is neither disclosed nor consistent with its purpose.

The Office Action's reliance upon asserted teachings that are in addition to that which is disclosed in the cited '169 reference is inappropriate as the basis for a Section 102 rejection and contrary to relevant law. Anticipation under Section 102 requires that a cited reference disclose all of the claim limitations. As the rejection relies upon modifications to the teaching in the '169 reference, the rejection does not comply with this requirement and the Section 102 rejection should be removed.

In addition to the above, the cited portions of the '169 reference also fail to disclose all of the claim limitations and do not function as suggested in the Office Action. None of cited paragraphs 0017, 0019, 0024 and 0037 mentions anything about a processor that "searches for a predefined second data piece stored in the storage medium" and that further supplies the second data piece when available or controls a transcoder to

produce the second data piece when unavailable (*i.e.*, as relevant to independent claims 1 and 6-9). The '169 reference does not store any second data set (or subset) that corresponds to the first data set in a different format that "has already been produced" and there is no motivation for doing so. Referring to paragraphs 0004 and 0008-0013, the '169 reference stores a "first data set" in a first format (*e.g.*, the data is encrypted) and uses an executable "second data set" to produce the first data set in a different format (*e.g.*, uses executable decryption software to decrypt multimedia data). The processed first data set does not appear to be stored, and such storage would appear to defeat the purpose of the '169 reference, which is achieved by storing data in a first format together with software on a memory that is used to provide the data in a different format. This purpose is useful for ensuring that any decrypted data "can thus not be copied easily by a user into another unencrypted file for subsequent non-encrypted playback" as discussed in paragraph 0032.

In failing to provide correspondence to independent claim 1, the '169 reference also fails to provide correspondence to claims 2-5, which depend from claim 1. In this regard, the Section 102 rejections of all of claims 1-9 are also improper because the '169 reference fails to provide correspondence to the claimed invention. Applicant requests that the Section 102 rejection also be removed for these reasons.

Applicant respectfully traverses the Section 102(e) rejection of claim 5 because the rejection relies upon an unsupported assertion of allegedly inherent teaching, without providing any support for the assertion. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter *is necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). In this instance, the Office Action has cited no supporting evidence and has not shown how the devices would be "necessarily present" in the '169 reference. The rejection of claim 5 is also improper for these reasons, and Applicant requests that it be removed.

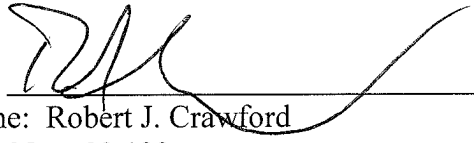
Applicant further traverses the Section 102(e) rejection over the '169 reference because the Office Action has not established that the cited portions of the '169 reference are entitled to a priority date that is before the priority date of the instant application. The '169 reference was filed on May 17, 2004, and makes a somewhat vague priority claim to provisional application numbers 60/471,151 and 60/502,851, respectively filed on May 16, 2003 and September 12, 2003. The instant application has a priority date of June 25, 2003. In this regard, only the material supported under Section 112 in provisional application no 60,471,151 (filed on May 16, 2003) would appear to be available as a reference citable in a Section 102(e) rejection. The Office Action has not indicated where in this provisional application any support for the cited portions of the '169 reference can be found. In this regard, it is unclear as to whether the cited portions of the '169 reference are entitled to a priority date that is before the priority date of the instant application. The Office Action has thus not established that these cited portions are prior art under Section 102(e) in a manner consistent with M.P.E.P. §2136.03, which requires that the provisional application support the subject matter relied upon in compliance with 35 U.S.C. § 112(1). Applicant therefore submits that the Section 102(e) rejections are improper and requests that they be removed.

Amendments have been made to the claims to place them in an appropriate format by removing example reference numbers as often consistent with foreign patent application approaches. These amendments do not introduce or remove any subject matter and are not made for reasons of patentability.

In view of the remarks above, Applicant believes that each of the rejections/objections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

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